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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: WALKER, et al.

Title: FREQUENCY-NARROWED
HIGH POWER DIODE LASER
SYSTEM WITH EXTERNAL
CAVITY

Appl. No.: 09/706,088

Filing Date: 11/03/2000

Examiner: Landau, Matthew C.

Art Unit: 2815



<p>CERTIFICATE OF MAILING</p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below.</p> <p>Callie M. Bell (Printed Name)</p> <p><i>Callie M. Bell</i> (Signature)</p> <p>April 6, 2005 (Date of Deposit)</p>

PETITION FOR RECONSIDERATION OF PTA UNDER 37 C.F.R. § 1.705(d)

Office of Patent Legal Administration
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This petition is being filed in response to an Issue Notification mailed March 15, 2005, relative to the above-identified application (Application). Request is hereby respectfully made, in accordance with 37 C.F.R. § 1.705(d), for reconsideration of the patent term adjustment (PTA) indicated in the enclosed Issue Notification. Applicants present the following facts, as set forth in 37 C.F.R. § 1.705, to support a PTA of 307 days and not the 187 days calculated by the PTO.

In determining PTA, Applicants' delay is subtracted from the PTO delay. The PTO delay includes 1) 215 days resulting from a failure to respond to an application within 14 months of filing (January 4, 2002 until August 6, 2002), and 2) 283 days resulting from the number of days in excess of three years from the date of filing the application until the date of issuance of the patent (June 6, 2004 until March 15, 2005). The period begins June 5, 2004

instead of three years after filing (November 4, 2003) based on a determination by the PTO that “the applicant failed to engage in reasonable efforts to conclude prosecution” for a period of 191 days. As a result, the PTO calculated the PTO delay as 498 days.

The PTO calculated Applicants’ delay as the 191 day period plus a 120 day period apparently resulting from the filing of a petition requesting reconsideration of the PTA submitted with the Notice of Allowance. As a result, the PTO calculated Applicants’ delay as 311 days resulting in 187 (498 – 311) days of PTA. However, according to the provisions of 37 C.F.R. § 1.704(e) included below, the 120 day period deducted by the PTO is incorrect.

Submission of an application for patent term adjustment under § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) **will not be** considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

37 C.F.R. § 1.704(e) (Emphasis added).

Thus, the correct PTA should be 307 (187 + 120) days.

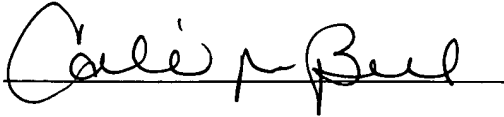
Enclosed herewith, in addition to the Issue Notification, is a check in the amount of \$200.00 to cover the fee associated with this request as specified in 37 C.F.R. § 1.18(e). However, Applicants respectfully request a refund of the petition fee because the error was due to no fault of the Applicants. Please also see the enclosed response from the PTO to the petition requesting reconsideration of the PTA submitted with the Notice of Allowance. The response from the PTO states that Applicants may request reconsideration within two months of the issue date (March 15, 2005) without payment of the fee.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2350 should any additional fee be found necessary.

Respectfully submitted,

Dated: April 6, 2005

FOLEY & LARDNER LLP
Customer Number: 23524
Telephone: (608) 258-4263
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By 

Callie M. Bell
Attorney for Applicants
Registration No. 54,989



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AUG - 9 2004

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IP DOCKETING

COPY MAILED

AUG 05 2004

In re Application of
Walker et al.
Application No. 09/706,088
Filed: November 3, 2000
Attorney Docket No. 032026:0486

DOCKETED

BY JD OFFICE OF PETITIONS 8/13/04

TICKLER

BY Colz DATE 8/13/04

ACTION (DUE DATE) Resp. to
Decision re PTA Determination
(9/24/04)

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 35 U.S.C. § 154(B)(3)(B)(II)," filed March 18, 2004. Applicants request that the patent term adjustment be corrected from twenty-four (24) days to either three hundred thirty-nine (339) or eighty-five (85) days. In part, applicants request that the patent term adjustment indicated in the patent be increased for the patent issuing more than three years after the filing date of the application.

The request for reconsideration of the patent term adjustment at the time of mailing of the notice of allowance is **DISMISSED**, except as to the request for time for over 3 years to issue, which is held in abeyance until the patent issue date is established.

Applicants are given **thirty (30) days** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

A decision on the request for reconsideration of the patent term adjustment indicated in the patent on the basis that the patent issued more than three years after the application filing date is being held in abeyance until after the actual patent date. Applicants are given **TWO (2) MONTHS** from the issue date of the patent to request reconsideration of the patent term adjustment indicated in the patent on this basis. Applicants may seek reconsideration on this basis without payment of the fee.

On December 24, 2003, the Office mailed the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 24 days. Applicants agree with the period of adjustment of 215 days for Office delay in mailing a first Office action under 35 U.S.C. 132. Applicants dispute the reduction totaling 191 days for applicant delay in responding to the non-final Office action mailed October 8, 2002. Applicants contend that using the certificate of mailing date, the PTA should have only been reduced by 61 days, not 68 days, for the

initial response mailed March 10, 2003, but received March 17, 2003. Further, applicants contend that the response received March 17, 2003 was fully responsive. Thus, the PTA should not have been further reduced by 123 days for the response filed July 18, 2003. (Likewise, applicants argue that any reduction based on the filing of the second response should be calculated based on the certificate of mailing date of July 15, 2003).

Applicants' arguments have been considered, but are not persuasive. First, of all, applicants' attention is directed to 37 CFR 1.703(f), which provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). Accordingly, the certificate of mailing dates of the responses filed March 17, 2003 and July 18, 2003 were properly not taken into account in calculating patent term adjustment. Thus, the reduction of 68 days for applicant delay in filing their initial response to the non-final Office action is correct.

In addition, the further reduction of 123 days is correct. The record does not support a conclusion that the Notice of Non-responsive Amendment mailed June 4, 2003 was mailed in error. Further, applicants responded to the Notice on the merits on July 18, 2003. Thus, it is concluded that the reduction of 123 days pursuant to § 1.704(c)(7) for submission of a reply correcting an omission was proper.

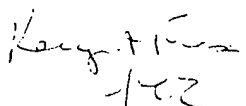
-It is further noted that on July 18, 2003, applicants also filed an Information Disclosure Statement. This IDS did not include a § 1.704(d) statement. Accordingly, if the PTA were not reduced by 123 days for submission of the response on July 18, 2003, pursuant to § 1.704(c)(8), the PTA would have been reduced by 123 days for submission of the IDS.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is twenty-four (24) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Publishing Division has been advised of this decision. The application is being processing into a patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (703) 305-0309.


Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,088	03/15/2005	6868099	032026:0486	5028

23524 7590 02/23/2005

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ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment is 187 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

APPLICANT(s) (up to 18 names are included below, see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

Thad G. Walker, Madison, WI;
Bien Chann, Madison, WI;
Ian A. Nelson, Madison, WI;

DOCKETED

BY SPD DATE 3/16/05

TICKLER

BY BA DATE 3/29/05

ACTION (DUE DATE) Broadening Reissue
(3/15/07)